

REMARKS/ARGUMENTS

In the Restriction Requirement dated October 1, 2009, the Examiner delineated the following inventions as being patentably distinct.

Group I: Claims 1-9, drawn to a method of using a radiation-curable laminated sheet;

Group II: Claims 10-11, drawn to a process of making laminated shaped articles; and

Group III: Claims 12-18, drawn to a radiation-curable laminated sheet.

Applicants provisionally elect with traverse the invention of Group I (Claims 1-9) drawn to a method of using a radiation-curable laminated sheet.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803).

The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims for the restricted groups are independent patentably distinct.

The claims of Groups I, II and III are related as product, method of making, and method of use, and as such are considered as being interdependent and should be examined together on the merits especially wherein the sole disclosed utility is that recited in the specification. The claims of Group II and II further define the invention of Group I. There is a commonality that exists between the groups. It is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the groups, taken as a whole, makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility.

Product and method of making are considered related inventions under 37 C.F.R.

§ 1.475(b) and unity of invention between the groups exists.

Applicants submit that while Rule 13.1 and 13.2 are applicable, 37 C.F.R. § 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention are considered to have unity of invention if the claims are drawn to ---
(3) product and method for making said product; and the use thereof.

Moreover, Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Examination Report did not the restriction is now believed to be improper.

Further, M.P.E.P. § 803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on its merits even though it includes claims to distinct and independent inventions.

For the reasons recited above, Applicants request that the Restriction Requirement be withdrawn.

Divisional applications filed thereafter claiming the non-elected subject matter should not be subject to double-patenting ground of rejection, 35 U.S.C. § 121, In re Joyce (Comr. Pats. 1957) 115 USPQ 412.

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is solicited.


Respectfully submitted,

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